

1. Oath/Declaration

On page 2, §1 of the Office Action, the Examiner states that the oath or declaration is defective because, in order to claim the present application as a continuation-in-part of a prior application, it is required to list the parent application in the duty to disclose section. The instant application is a continuation of application Serial No. 08/378,617. Enclosed is a signed supplemental declaration and power of attorney for the instant continuation application which refers not only to all parent applications but also to a Preliminary Amendment made in this case.

2. The §102 rejections

(a) Claim 1 stands rejected under 35 U.S.C. §102(a) as being anticipated by Sandrin et al., 1995 (X). Applicants respectfully traverse this rejection.

Applicants submit that in light of the above amendment to the specification, in which priority to application number 08/188,607 is claimed, Sandrin et al. (a GenBank data base submission dated January 3, 1995) is not prior art with respect to the instant application.

(b) Claim 3 stands rejected under 35 U.S.C. §102(a) as being anticipated by Gustafsson et al., 1994 (W). Applicants respectfully traverse this rejection.

Applicants submit that in light of the above amendment to the specification, in which priority to application number

08/188,607 is claimed, Gustaffson et al. (a scientific publication which Applicants believe was first made public on October 25, 1994) is not prior art with respect to the instant application.

(c) Claims 1-3 stand rejected under 35 U.S.C. §102(e) as being anticipated by Sandrin and McKenzie, 1998 (A). Applicants respectfully traverse this rejection.

Applicants submit that in light of the above amendment to the specification, in which priority to application number 08/188,607 is claimed, Sandrin and McKenzie (a U.S. patent with a filing date of March 15, 1994) is not prior art with respect to the instant application.

In view of the above considerations, Applicants respectfully request that the rejections under 35 U.S.C. §102 be withdrawn.

3. The §103 rejection

Claims 1, 2, 46-51, and 63-67 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gustaffson et al., 1994 (W) in view of Seamark, 1994 (V) and Sandrin et al., 1995, (X). Applicants respectfully traverse this rejection.

In light of the above remarks with respect to the 35 U.S.C. §102 rejections, neither Gustaffson et al. nor Sandrin et al. are prior art references. Similarly, in view of the above amendment to the specification in which priority to application number 08/188,607 is claimed, Seamark (a scientific publication

which was only received by the journal editors on April 14, 1994) is not prior art with respect to the instant application.

In light of the above considerations, Applicants request that the rejection under 35 U.S.C §103(a) be withdrawn.

4. The §112, second paragraph, rejection

Claims 1-3 stand rejected under 35 U.S.C. §112, second paragraph for being vague and indefinite as the phrase "standard high stringency conditions" is indefinite.

While Applicants do not agree that the phrase "standard high stringency conditions" is indefinite, in the interest of expediting prosecution, Applicants have amended claim 1 by deleting this phrase and inserting "after a wash at 65°C in a buffer containing 0.1% SDS and not greater than 0.5 x SSC". In addition, Applicants have added new dependent claim 68 that specifies the limitation of a wash in 0.05 x SSC and 0.1% SDS at 65°C. Support in the specification for the amendment to claim 1 and new claim 68 is on page 7, lines 11-14.

In light of the above considerations, Applicants request that the rejection under 35 U.S.C. 112, second paragraph, be withdrawn.

5. The §112, first paragraph, rejections

Claims 61-66 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the

application was filed, had possession of the claimed invention. In addition, claims 52-66 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most clearly connected, to make and/or use the invention. In light of the cancellation of claims 52-66, both these rejections are moot. Applicants retain the right to submit claims 52-66, and additional related claims, in a separate application.

CONCLUSION

In summary, for the reasons set forth above, Applicants maintain that claims 1-3, 46-51, and 67 clearly and patentably define the invention. Applicants request that the Examiner reconsider the rejections as set forth in the Office Action, and permit the pending claims to pass to allowance.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' undersigned representative can be reached at the telephone number listed below.

Please charge any additional fees or make any credits
to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 8/27/99

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